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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,431	08/10/2001	Alberto Gonzalo Perez Roldan	P56378	4119

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EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,431

Applicant(s)PEREZ ROLDAN, ALBERTO
GONZALO**Examiner**

Margaret B. Medley

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/14/03, 9/24/03/10/28/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9,15,16,21-39 and 50-56 is/are pending in the application.
- 4a) Of the above claim(s) 42-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,15,16,21-39 and 50-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s) 19/21/24/03
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

This office action is in response to:

I. Applicants' reply (amendment) dated August 14, 2003 directed to:

- A) Previously amended claims 1-9, 15-16, 21, 24, 31 and 33-34;
- B) Originally filed claims 22-23, 25-30, 32 and 35-39;
- C) Previously added claims 41-51;
- D) Canceled claims 10-14, 17-20 and 40; and
- E) Withdrawn claims 41-49.

II. Personal Interview with Attorney Robert E. Bushnell and Attorney Jong Park.

III. Applicants' reply (supplemental amendment) dated September 24, 2003

directed to:

- A) Previously amended claims 1, 6, 15-16, 21, 31 and 41;
- B) Currently amended claims 2-5, 7-9, 22-24, 29-30, 32-34 and 39;
- C) Originally filed claims 25-28 and 35-38;
- D) Previously added claims 42-51;
- E) Canceled claims 10-14, 17-20 and 40; and
- F) Withdrawn claims 41-49.

IV. Telephone Interview with Attorney Robert E. Bushnell on October 15, 2003.

V. Telephone Interview with Attorney Robert E. Bushnell on October 16, 2003.

VI. Telephone interview with Attorney Robert E. Bushnell on October 21 and 26, 2003.

VII. Applicants' reply dated (amendment) dated October 28, 2003 directed to:

- A) Previously amended claims 1-9, 15-16, 21-24, 29-34 and 39;
- B) Original added claims 25-28 and 35-38;
- C) Previously added claims 50-51;
- D) Canceled claims 10-14, 17-20 and 40;
- E) Withdrawn claims 41-49; and
- F) Newly added claims 52-56.

VIII. Telephone Interview with Attorney Robert E. Bushnell on October 29, 2003.

The replies dated August 14, 2003, September 24, 2003 and October 28, 2003 have been entered of record. The pending claims of record are claims 1-9, 15-16, 21-39 and 41-56 of which claims 41-49 are directed to the non-elected invention.

The response to applicant's petition filed on April 25, 2003 is being forward under a separate response.

The examiner's previous appearance of allowable subject matter of claims 4 and 9 are withdrawn in view of applicant's amendments to the claims and the rejections set forth below.

Newly submitted claims 41-49 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 15-16, 21-39 and 50-56, drawn to candle compositions, classified in class 44, subclass 275.
- II. Claims 41-49, drawn to a process of manufacturing a candle, classified in class 264 or class 431, subclass 239+ and 288, respectively.

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the candle compositions and candles of pending claims 1-9, 15-16, 21-39, and 50-56 can be made by a process other than the process of claims 41-49, for instance the candle compositions and candles can be made by heating the mixture of oil and polymer and shaking the mixture until the polymer is solubilized or dissolved into the said oil. The process of claims 41-49 can be used to make a product other than the candles and candle composition. For instance the process can be used to produce gel air refreshner.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

It would cause an undue burden on the office to search and prosecute the newly added invention directed to newly added claims 41-49.

A review of the parent application EP 1,188,815 A2 dated March 20, 2002 of the instant pending application reveals claims directed to only candle compositions and candles of the same or similar scope of the candle compositions and candles of the instant application. There were no claims found in the parent application directed to a process for manufacturing a candle or candle composition of the newly added claims 41-49.

For the above reasons, the examiner maintains the position of record that the instant claims 41-49 are directed to a newly added invention and the restriction requirement is proper. Therefore the restriction should be maintained and claims 41-49 should be withdrawn from consideration.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 41-49 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Note: In the event that the elected composition claims are found to be allowable, then pursuant to the rejoinder procedure stated in MPEP 821.04, should the nonelected

process claims be made to depend from or otherwise include all the limitations of the allowable composition claims the process claims will be rejoined.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8, 15-16, 21, 23, 25-26, 27, 30, 31, 33-37 40-53 and 55-56 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Camp et al (Camp) 5,964,905 combined with Petro-Canada Tech Data Sheets for PURITY Grade "Typical Properties and LUMINOL^R T "White Mineral Oil".

Camp teaches and discloses candle compositions and candles comprising a wick, about 80-98 % wt. Mineral oil (e. g. PURITY 50 AND LUMINOL T 50), col. 3, lines 6-18, and Examples 1-2, having a flash point (F.P.) of at least 227⁰ C (400⁰ F) or greater, generally between 254⁰ C and 260⁰ C (4400 F) that inherently would have a viscosity of greater than 32 cSt and a viscosity of 67.8 cSt at 40⁰ C, a density at least 200⁰ C of < 0.88 Kg/L and being liquid within a temperature range between 0⁰ C and

200⁰ C, and 1-20 % wt. Of a commercially available tri-block copolymer comprising segments of polystyrene and rubber sold under the trademark KRATON^R G series comprising styrene-ethylene butylenes-styrene structure (col. 2, lines 20-26 and 53 to col. 3, line 5. Camp further teaches the inclusion of scents, terpenes and essential oils, col. 3, lines 22-32 and Example 1 and colorant or dye, col. 3, line 34 and Example 1 that anticipates the instant claims proportional of hydrocarbon oils and polymers, the viscosity and flash point and further inclusion of the density physical properties of the hydrocarbon oils wherein the examiner takes the position that since the oils of Camp are white mineral oils with flash points within the range of the instant claims that the oils of patentee would inherently have the same viscosity and density. The further inclusion of conventional candle additives including scents, terpenes and essential oils and colorant and dyes further anticipate the instant claims.

If applicant deems the claims not to be anticipated then in the alternative the claims are rendered obvious over Camp combined with the teaching references of Petro Canada Tech Data Sheets for PURITY Grade and LUMINOL T.

The Petro Canada Tech Data Sheets are relied on as teaching references to show that it is well-known and conventional in hydrocarbon white mineral oil (WO) that the white mineral oils of Camps having F.P. of >2200 C or =>2400 C, inherently have a viscosity of >32 cSt or => 67.8 cSt at 400 C and density of not less than 0.88 Kg/L.

The tech data sheet for PURITY White Oils (WO) set forth the commercially available typical properties for grades of PURITY, e. g., PURITY 50 as having viscosity of 95-115 cSt at 40⁰ C, density of 0.874 at 15⁰ C and density of 0.860-0.880 at 25⁰ C

which inherently set forth the density as being not less than 0.88 Kg/L at 20° C and a F.P. of 268° C, note the last item of the Table, and that PURITY 35 set forth a viscosity of 66-71 at 40° C and density of 0.871 and density of 0.855-0.880 at 25° C and a F.P. of 240° C that clearly shows that the white mineral oils of Camps inherently have the viscosity and density that anticipate or in the alternative render obvious the instant claims.

The tech data sheet for LUMINOL T- White Mineral Oil set forth the commercially available typical properties for LUMINOL T500 as having a density of 0.874 at 15° C, a viscosity of 100 at 40° C and a F.P. of 268, and LUNINOL T35° as having a density of 0.871 at 15° C, a viscosity of 68.4 at 15° C and a F.P. of 240° C that clearly shows that the white mineral oils of Camp inherently have the viscosity and density that anticipate or in the alternative render obvious the instant claims. The examiner takes the position on record that the density of LUMINTOL T500 and LUMINTOL T350 inherently would have the same density at 20° C as the mineral oils of PURITY 50 and PURITY 35 since all four oils have the same density at 15° C.

The examiner takes the position on record that the candle compositions and candles of Camp inherently have the same properties as being elastic, transparent and free standing as the candle compositions and candles respect to the candle compositions and the candles having the property as being elastic, transparent and free standing and maintaining a free standing condition even when the candle is lit.

The examiner takes this position since the relative proportions of hydrocarbon oils and polymer are the same and the said oils and polymers are the same and inherently have the same properties.

The gel-like nature of the block copolymer candle compositions of and candles of Camp and those of the instant claims are similar to the gel-like nature of the polyamide in that while a "free-standing" structure may be formed from each of these gels, such structures are "free-standing" only in the sense that JELL-OTM, a well-known gelled food product, is free-standing. Thus a portion of JELL-OTM may be placed on a plate and will maintain itself at some height above the plate, without being contained. In this sense, JELL-OTM and the gel candle compositions and gel candles of Camp are indeed freestanding. However, consumers desire candles with a free standing-pillar structure, and while such a structure might be made from a material with the consistency of JELL-OTM, it would only precariously hold the pillar structure----one little tap and the pillar would have the potential to flop over. Another reason why gel candles are often recommended for use in containers as opposed to being freestanding is due to the potential flowability of a gel of a gel candle when it is heated. In any event, potential flowability issues associated with a gel candle can be avoided by placing the candle in a container, which is the approach often recommended in the prior art. Also, containers are used with gel candles and other candles for decorative purposes. Therefore, Camp anticipates or in the alternative renders obvious the transparent, elastic and freestanding properties of the candle compositions and candles of the instant claims, as well as, the absence use of a container with the composition and candles of the instant

claims. A more viscous molten gel will tend to incorporate and retain more air bubbles. The presence of air bubbles in a cooled candle will cause the candle to have a translucent, rather than the desired transparent or clear appearance.

Camp clearly teaches pouring the candle composition into pre-wicked containers wherein the wick is of cotton material, col. 2, lines 1-7, at a temperature of 115-121⁰ C (240-250⁰ F) that would inherently produce air within the gel mixture to anticipate an in the alternative render obvious the air bubbles of instant claim 27, note example 1 of cols. 3-4.

Claims 22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camp et al (Camp) 5, 964,905 combined with Petro-Canada Tech Data Sheets for PURITY Grade "Typical Properties and LUMINOL^R T "White Mineral Oil" as applied to claims 1-3, 5-8,15-16, 21, 23, 25-26,27, 30-31,33-37, 50-53 and 55-56 above, and further in view of Tsaras 3,844,706.

Applicants further claim that the wick is imbibed in an alcoholic solution of vegetal resin(pine resin) wherein Camp and the combined Data Sheets are silent to said teachings.

Tsaras teaches candle compositions and candles comprising a body of ethyl cellulose and glyceride, the bridging paragraph of cols. 1-2, and that natural resins e.g. vinsol (pine resin) having compatibility with said mixture, col. 8 lines 20-22, and that the wick is adapted to be impregnated by a candle body blend of said composition, col. 2, lines 6-24 and figures 1 and 2 that teaches a wick imbibed with alcoholic solution of vegetal (pine resin) rendering obvious instant claim 27.

Claims 24, 28-29, 38-39 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camp et al (Camp) 5,964,905 combined with Petro-Canada Tech Data Sheets for PURITY Grade "Typical Properties and LUMINOL^R T "White Mineral Oil" as applied to claims 1-3, 5-8,15-16, 21, 23, 25-26,27, 30-31,33-37, 50-53 and 55-56 above, and further in view of Morrison et al (Morrison) 5,879,694 and 6,066,329.

Applicant further claims candles produced form by union of a plurality of different minor portions (instant claims 24 and 34) and the further inclusion of decorative elements in the candles (instant claims 28-29 and 38-39) wherein Camp with the combined teaching references are silent to said teachings.

Morrison teaches candle comprising hydrocarbon oils and copolymers in the same relative proportion and inherently having the same or similar properties wherein the said candle is produced from plurality minor portions, col. 7, lines 24-25 of '694 and col. 7, lines 62-65 of '329 and that the candles provides for the further inclusion of decorative elements, col. 7 lines 34-60 of '694 and col. 8, lines 7-35 of '329 providing the motivation to further use the union of the plurality of different minor portions of the composition of Morrison to produce the candle of Camp and include decorative elements of Morrison in the candles of Camp that further render obvious the instant claims.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camp et al (Camp) 5,964,905 combined with Petro-Canada Tech Data Sheets for PURITY Grade "Typical Properties and LUMINOL^R T "White Mineral Oil" as applied to claims 1-

3, 5-8, 15-16, 21, 23, 25-26, 27, 30-31, 33-37, 50-53 and 55-56 above, and further in view of C. M. Roland "Kraton G 1600 SEBS".

Applicant further claim a candle comprising a triblock polymer having specific tensile strength, elongation and 300% modulus wherein Camp with the said combined teaching references is silent to some of said specific properties.

Roland set forth the said specific properties for well-known Trademarks triblock Kraton G1650 and Kraton G1652 having S/B/S block of 15/70/15, 300% modulus of 3.8 Mpa and 5.5% Mpa, respectively, tensile strength of 26, Mpa and 27 Mpa, respectively, and elongation of 560% and 520%, respectively, note page 1. It would have been obvious to the artisan in the art with the teaching of Roland that the properties of the Kraton 1650 of Camp are similar to the Kraton 1652 to substitute Kraton 1650 with the Kraton 1652 to act as a gellant agent in the hydrocarbon oil of Camp with the reasonable expectation of success to produce a transparent, elastic and free-standing candle, especially in the absence of evidence to the record to the contrary.

The disclosure is objected to because of the following informalities: The term "compound" e.g. in line 2 of the first paragraph under The Summary of the Invention and throughout the instant specification should be corrected to read as "composition", especially in light of the correction made to the title of invention.

Appropriate correction is required.

Claims 3, 27 and 54 are objected to because of the following informalities: In claim 3, line 2 the term "is" should be insert between "oil" and "at" for clarity. In claim

27, line 1 the spelling of the term "forth" should be corrected. In claim 54, line 4, the spelling of the term "of" should be corrected. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1, 4-5, 6, 7-9, 15-16, 21-22-30, 31, 39 50 and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "at least one copolymer selected from the group" is an improper Markush group appearing in claims 1, 6, 15, 21, 31 and 50 (and their dependent claims) rendering the scope of the claims indefinite. The rejection may be overcome with the insertion of the term "consisting" between the terms "group" and "of".

Applicant's arguments filed August 14, 2003, September 24, 2003 and October 28, 2003 have been fully considered but they are not persuasive.

Applicants' arguments with respect to the two new references that were faxed applicants on October 15, 2003 with respect to the viscosity of the hydrocarbon oils and arguments 1, 2, 3 and 4 presented on page 16-17 of the October 28, 2003 reply are deemed moot in view of the new rejections set forth above that have addressed the viscosity, flash point and ranges of hydrocarbon oils and the copolymer and the free standing property of the candle compositions and candles.

The examiner has noted applicant's withdrawal of claims 41-49 in this response dated October 28, 2003.

The examiner has provided applicant with viscosity for PURITY 50 AND LUMINOL T, but not for the SEMTOL as indicated in the September 11, 2003 interview. The indicated allowable subject matter of claims 4 and 9 are withdrawn in view of the new rejections set forth above. The rejection of claims 2-5, 7-9, 22-24, 29, 30, 32-34 and 39 are withdrawn in view of applicant's amendment to the said claims set forth in the September 24, 2003 reply.

The restriction is maintained as being proper for the reasons set forth above that also render moot applicant's arguments set forth in the August 14, 2003 reply. The new rejections set forth above render moot applicant's arguments set forth on pages 15-24 of the August 14, 2003 reply with respect to the 103 rejections. Claims 2, 7, 4 and 9 have been addressed above.

The instant claims of records do not appear to contain any allowable subject matter.

So that applicant may have ample time to review and consider the tech data sheets for PURITY 50 and LUMINTOL T 500 supplied by the examiner as indicated in the September 11, 2003 interview, the examiner will not make this response final.

The prior art made of record and not replied upon further teaches candle compositions and candles comprising components of the same as the instant claims.

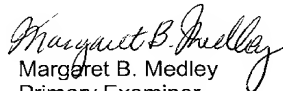
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 6:00 PM.

Application/Control Number: 09/925,431
Art Unit: 1714

Page 15

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret B. Medley
Primary Examiner
Art Unit 1714

MBMedley
November 4, 2003